

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATHERINE GRACE AUGUST,
NORMAN R. SHAER,
and THEODORE SIZER II

Appeal 2007-0146
Application 09/503,096¹
Technology Center 2100

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Decided: March 8, 2007

Before LEE E. BARRETT, HOWARD B. BLANKENSHIP, and JEAN R. HOMERE, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-26.

We reverse, but enter a new ground of rejection.

¹ Application for patent filed February 11, 2000, entitled "Method and System for Capture of Location of Specific Media Related Information and Delivery Through Communications Network."

BACKGROUND

The invention relates to a method for delivering specific data related to a principal program (e.g., a television program) to a subscriber through a communications network. In one embodiment, a recipient of a television broadcast can receive Web addresses or telephone numbers that relate to the broadcast (specification 12, ll. 13-16).

Claim 1 is reproduced below. The comma in brackets on the third line should be omitted because it does not appear in claim 1 as originally filed; its presence appears to be an inadvertent error that occurred in the first amendment of February 24, 2004, and has been carried forward since then.

1. A method for delivering specific data related to a principal program, to one or more subscribers receiving said principal[,] program, said method comprising:

embedding a watermark within said principal program, first transmitting said principal program with the embedded watermark to said one or more subscribers;

decoding said embedded watermark to determine the specific related data to be transmitted to said one or more subscribers, the specific related data including at least one of an offer to said one or more subscribers, telephone number, World Wide Web address, coupon, and advertisement; and

second transmitting, in response to said decoded watermark, said specific data related to said principal program to said one or more subscribers through a communications network.

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THE REFERENCES

The Examiner relies on the following references:

Moskowitz	US 5,822,432	Oct. 13, 1998
Chen	US 6,314,192 B1	Nov. 6, 2001
		(filed May 21, 1998)

THE REJECTION

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen and Moskowitz.

DISCUSSION

Appellants argue that each of independent claims 1, 4, 14, and 15 recite one of a transmitting and delivering step which is triggered *in response to* information extracted or decoded from a watermark in a signal. It is acknowledged that Chen teaches transmitting an encoded signal including a watermark to a receiver and decoding the signal, but it is argued that Chen does not disclose or suggest a transmitting or delivering operation in response to the decoding of the watermark (Br. 7). It is noted that the Examiner alleges (at Final Rejection 2-3) that Chen teaches the claimed responsive transmitting step at column 1, lines 34-38, but Appellants argue that this portion of Chen relates to coding and decoding functions performed when sending and receiving a watermark, respectively, and not any operations performed based on the extracted watermark (Br. 7). Therefore, it is argued, Chen does not teach "transmitting, in response to said decoded watermark, said specific data related to said principal program to said one or

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more subscribers through a communications network," as recited in claims 1 and 4, or a "delivery means for delivering said specific data related to said principal program to a receiving device associated with said one or more subscribers in response to the decoded watermark," as recited in claims 14 and 15. It is argued that Moskowitz is applied for deficiencies of Chen unrelated to transmitting or delivering specific data related to a principal program in response to watermark extraction (Br. 7-8).

The Examiner disagrees (Answer 13): "Chen's system teaches 'decoding' functions that seek to extract the watermark signal from the composite signal. This such 'decoding' functions may also be referred to as **transmitting and receiving functions**, indicating that the composite signal is transmitted over a channel to the receiver (column 1, 34-38 of Chen)."

The Examiner misapprehends the cited portion of Chen or the claim limitations at issue. Chen discloses "coding" functions to embed watermarks and "decoding" functions to extract the watermark, which are referred to as transmitting and receiving functions, respectively; i.e., "coding" corresponds to transmitting and "decoding" corresponds to receiving. There is nothing at column 1, lines 34-38, which discloses or suggests a transmitting and delivering step which is triggered *in response to* information extracted or decoded from a watermark in a signal, as claimed. While it may be that something must be inherently done with the data extracted from the watermark for it to be useful, Chen does not disclose it. Chen is concerned with the encoding and decoding task.

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We also agree with Appellants that the Examiner applies Moskowitz to meet the limitation of "the specific including at least one of an offer to said one or more subscribers, telephone number, World Wide Web address, coupon, and advertisement," as discussed at pages 4-5 of the Examiner's Answer. Moskowitz is not asserted by the Examiner to disclose or suggest a transmitting or delivering step which is triggered *in response to* information extracted or decoded from the watermark, and so does not cure the deficiencies of Chen.

Appellants argue that the Examiner proposed new arguments in the Final Rejection, pages 11-13, stating that the operations of the information extractor 202 teach a transmitting and delivering step which is triggered *in response to* information extracted or decoded from a watermark (Br. 8).

Although we do not interpret the Examiner's discussion of the information extractor 202 as alleging that the operations teach transmitting and delivering in response to extracted information, we agree with Appellants that the information extractor in Chen only extracts information and does not do anything with it.

Appellants further disagree with the Examiner's statement that "the applicant also admits in the remarks that Chen does teach the claimed invention (see last three lines of page 8)" (Final Rejection 12) because the remarks are not directed to the transmitting and delivering steps being argued (Br. 8).

We agree that Appellants have made no admissions that the limitations at issue are taught by Chen.

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For the reasons stated above, we conclude that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the independent claims. Accordingly, the rejection of claims 1-26 is reversed.

NEW GROUND OF REJECTION

Claims 1-8, 14, 15, 17, and 24-26 are rejected under 35 U.S.C. § 102(e) over Thrift, U.S. Patent 6,510,557, issued January 21, 2003, filed October 3, 1997.

With respect to independent claims 1, 4, 14, and 15, Thrift discloses an apparatus for integration of television signals and information from an information service provider, e.g., displaying a television program ("principal program") and a related Internet Web page ("specific data related to said principal program") on different parts of a display screen (Figure 3). As broadly defined by Appellants, "[t]he watermark is an electrical signal encoded within the signal of the transmitted program, but which is imperceptible to the human eye or ear" (specification, page 6). Information related to the program in Thrift is stored as a signal in the vertical blanking interval (VBI), which is not perceptible to the human eye or ear; thus, the information encoded in the VBI fits Appellants' definition of a "watermark." VBI information from a VBI decoder 28 ("decoding said embedded watermark") is sent to a Java television platform (JTCP) 12 which is connected to an Internet service provider via an Internet connection. In one embodiment, "information stored in the vertical blanking interval would send a URL to the JTCP 12 and the web page would be retrieved" (col. 4,

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lines 57-59), where the URL is a "World Wide Web address," corresponding to the claimed "specific related data." The URL can be "specific data related to the principal program" as evidenced by the examples of sending a URL for the Discovery Channel when the viewer is watching a program on the Discovery Channel or displaying an advertising Web page during a commercial break (col. 4, line 59 to col. 5, line 9). The data is transmitted or delivered to a television receiver (a "receiving device") where it is displayed to the subscriber. Data is transmitted or delivered through wires, which constitute a "communications network," as broadly recited in claims 1 and 4, or a "delivery means," as recited in claims 14 and 15. Alternatively, the Internet connection from which data is received can be considered the "communications network." The data from the Internet is delivered "in response to said decoded watermark." This appears to be the identical method described by Appellants (specification, page 1): "In one specific example a recipient of a television broadcast can receive web addresses . . . that relate to the broadcast."

The decoding is done at a receiver located at a subscriber as recited in claims 2 and 5. The receiving and decoding apparatus in Thrift can be considered at a "central location," as recited in claims 3 and 6, because the "central location" is not defined, and the apparatus can be central to a subscriber's home.

The limitation in claim 7 of "a pointer to said specific related data stored in a database, further comprising the step of retrieving said specific data from said database prior to said transmitting step," is met because a

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Web address is a "pointer" to data stored in a server somewhere on the Internet and the Web page is retrieved before it is sent to the television receiver of the subscriber.

The information in the VBI is "specific related data," as recited in claim 8.

The Web page specific related data is delivered by an IP server to an Internet enabled application on a Web enabled device, the JTVP, as recited in claim 17.

The Java television receiver in Thrift is a set top box as recited in claim 24.

Thrift inherently has a transmitter as recited in claim 25 and delivery means to deliver the principal program (the television program) to a subscriber, as recited in claim 26.

CONCLUSION

The rejection of claims 1-26 is reversed.

A new ground of rejection has been entered as to claims 1-8, 14, 15, 17, and 24-26.

This decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

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37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

REVERSED - 37 CFR § 41.50(b)

PGC

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